1638

#3/Elec.

12/11/02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re of the Application of

Normand Brisson et al.

Serial Number: 09/851,084

Filed: May 9, 2001

For: MAPPING MOLECULAR INTERACTIONS IN PLANTS WITH PROTEIN FRAGMENT COMPLEMENTATION ASSAYS

Group Art Unit: 1638
Examiner: Cynthia E. Collins

ELECTION WITH TRAVERSE UNDER 37 CFR 1.143

Hon. Commissioner of Patents
and Trademarks
Washington, D.C. 20231

Dear Sir:

Responsive to the Office Action dated October 2, 2002, with the period for response extended two months (a check in the amount of $ is enclosed for a two month extension of time) and in compliance with 37 CFR 1.143, Applicant provisionally elects with traverse the Group I invention (claims 1-6) directed to a method of expressing PCA interacting partners in plant material comprising:

(A) transforming said material with:

(1) a first construct coding for a first fusion product comprising

(a) a first fragment of a first molecule whose fragments can exhibit a detectable activity when associated and

(b) a first protein-protein interacting domain; and

(2) a second construct coding for a second fusion product comprising

(a) a second fragment of said first molecule and

(b) a second protein-protein interacting domain that can bind (1)(b);

(B) culturing said material under conditions allowing expression of said PCA interacting partners, and

(C) detecting said activity.

Applicants respectfully request that the Examiner unify all the Groups for one simple reason: The invention strategy is based on protein fragment complementation assays. It is clear to applicant that the claims of the present invention which are not unduly multiplied uses the complementation of enzyme fragments. Products, assays and methods should be searched simultaneously. There is no serious burden on the Examiner to consider all the claims simultaneously.

The restriction requirement is respectfully traversed. 35 USC 121 is permissive, not mandatory, and accordingly MPEP 808 requires not only full clarification of the reasons why inventions as claimed are independent and distinct but also the reasons for insisting on restriction therebetween.

The Examiner has restricted the 26 claims as filed (considering new Director Rogan's grandiose plan for the 21st century – it appears to applicant that the number of claims is exceptionally reasonable for Examination all at once) into IX groups.

The restriction into nine groups does not appear reasonable given the total number of claims the Examiner has to consider on the merits. The patent office needs to establish once and for all its ability to provide the public with fair examination and treatment of applicant without unduly multiplied restriction. Restriction practice should be abolished

immediately once and for all. The small entity can not be expected to file an additional eight divisional cases to satisfy the patent office money needs. The Examiner is urged to consider all claims as filed without restriction.

Furthermore, the Commissioner's notices appearing in 934 OG 2 and 922 OG 1016 urge examination of an entire application on the merits if this can be made without serious burden on the Examiner, even in cases which includes claims to distinct or independent inventions, which frankly in this application is not the case since protein fragment complementation as applied to the instant application can be searched simultaneously. Applicant believes that the entire invention as claimed can be examined without serious burden to the Examiner.

Applicant queries as to why a restriction requirement was given by the Examiner.

Applicants' request reconsideration of the restriction requirement. Additionally, ***Applicant believes that there is unity of invention as required by M.P.E.P. 800.*** Also, with the advent of electronic database searching, how can there be undue burden on the Examiner to conduct a search relating to the present invention as embodied in claims 1-26 as originally filed?. The above does not appear to be a big burden.

Applicant respectfully requests and urges the Examiner to examine the present application as a whole. Because of the new GATT rules, it is respectfully requested that this application be examined in its entirety since it is not clear still as of 2002, what the patent office policy will be regarding divisional practice. Certainly, applicant feels strongly that if the patent office restricts an application, applicant is entitled to twenty years for each divisional application from the filing date of each divisional, not the earliest filing date

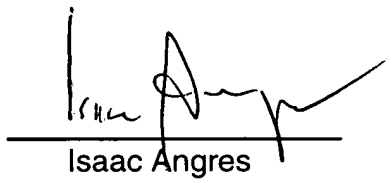
of the original application, especially if the patent office is telling applicant that he has nine distinct inventions in the current application. Also, it is noted that the restriction requirement fails to clearly state that the many inventions are independent and distinct, rather, only distinct. If, the Patent and Trademark Office intends to divide the present application into a plurality of Examiner-determined inventions and restrict prosecution of the present application to one aspect of the subject matter which Applicant regards as his invention, equity requires that the factual basis for so holding be clearly delineated so that the record will reflect if such a requirement is proper under 35 USC 121.

The importance of the written record clearly setting forth the reasons upon which a restriction requirement is based, particularly with respect to claims to a compound or composition held patentably distinct by the Patent and Trademark Office over method of use claims, is increasingly apparent from a brief filed by the Justice Department in U.S. v. Union Carbide Corp., an antitrust action in the U.S. District Court for Northern California seeking to invalidate U.S. Patent 3,009,855 on the insecticide "Sevin". In that case, the Patent and Trademark Office had insisted that the original application, claiming both a product and method of use, be restricted and merely alleged that the two constituted "distinct" inventions. Applicants retained product claims in the original application and canceled method claims which were presented in a divisional application. Some 20+ years later, the Justice Department argued in its brief that the restriction requirement was clearly not authorized under 35 USC 121, since the statue imposes the dual criteria that restrictable inventions must be both independent and distinct, stating in its brief:

...it is clear that the product carbaryl and its only disclosed use, e.g., killing insects, are not "independent and distinct" inventions. Since the first application expressly discloses how to use carbaryl as an insecticide in order to meet the statutory requirements for patentability, it cannot properly be said there is "no disclosed relationship" between the product carbaryl and its disclosed use as an insecticide. Nor can it be correctly said that the product carbaryl is "unconnected in design, operation or effect" with its use to kill insects. Thus it is clear that the restriction requirement which was imposed on the first application lacked authority under 35 USC 121 because that application did not claim "two or more independent and distinct inventions"..

In view of the above, reconsideration and withdrawal or at least clarification of the restriction requirement and an early action on the merits are courteously requested.

Respectfully submitted,



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